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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,905	01/14/2004	David Godbout	29617/PM489C	3083

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EXAMINER

FAISON GEE, VERONICA FAYE

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,905

Applicant(s)

DAVID GODBOUT

Examiner

Veronica Faison-Gee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al (US Patent 5,489,331).

Miller et al teach a multiple coloring composition system comprises: a) an undercolor aqueous coloring composition comprising an undercolor dye whose coloring ability is destroyed in the presence of an acid; and b) an overcolor aqueous coloring composition comprising a colorant capable of maintaining its characteristic color in the presence of a pH of about 4 or less; and an acid sufficient to bring the pH of the overcolor composition to about 4 or less (abstract and col. 3 lines 1-21). The reference further teaches that the acid may be phosphoric acid (the preferred acid), sulfuric acid, and citric acid (col. 6 lines 61-67). The dye present in the overcolor may be a triphenylmethane dye such as Acid Blue 93 and Acid Violet 19 (col. 4 line 61-col. 5 line 8), which Applicant claims as eradicable dye. The reference does not disclose viscosity of the composition. However, the composition of the reference is identical to the claimed composition and identical composition must have the same properties. See MPEP 2112.01 I. For these reasons, the composition of the reference is presumed to

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inherently possess the claimed properties. The composition as taught by Miller et al appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-8, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US Patent 5,649,999) in view of Kawashima (US Patent 4,907,903).

Wang teaches an ink/eradicator fluid combination includes an ink containing a dye and a binding agent, and an eradicator fluid containing a basic nitrogen compound (abstract and col. 1 lines 27-40). The ink contains a triaryl methane dye, a metal salt capable of binding to the amine used in the eradicator fluid, an organic acid, a polyacrylates film-forming polymer and water. The eradicator fluid includes a non-volatile amine capable of decolorizing the triaryl methane dye, a film-forming polymer and water (col. 2 lines 28-35). The preferred ink composition has a viscosity between 1 cps and 3 cps (col. 3 lines 12-14). The eradicator fluid contains a buffer to maintain the pH of the solution between 11 and 12 and the film-forming polymer may be a polyacrylic acid (col. 3 lines 18-60). The reference further teaches that other conventional ingredients such as bactericides, thickeners and colorants can be included in the ink or the eradicator fluid (col. 4 lines 11-13). The preferred inks and eradicator fluids can be

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used in roller ball pens, which include a tubular member for fluid communication with a reservoir; a socket, having a seat, at one end of the member, an interior wall surface extending from the seat; a rim disposed at the end of the interior wall surface opposite the seat; and a spherical ball that is disposed in the socket. The ink and eradicator fluid may be supplied in separate pens or may be supplied in a single pen, containing a reservoir for each (col. 4 lines 11-40).

Kawashima teaches a representing utensil for use in making an invisibly depicted matter visible again which houses a coloring assistant in its own container, wherein the coloring assistant is able to make a colorlessly depicted matter develop color and after its coloring, do the short-time fading at which time by acting on the depicted matter with the aid of a coloring agent (abstract and col. 1 lines 61-68). The reference teaches that the coloring agent may include an alkaline pH-indicator such as phenolphthalein, o-cresol phthalein, and bromophenol (col. 2 lines 18-33). The reference discloses that the pH-indicators may be dissolved by using alkaline solution or alcohol, wherein the solvent can be evaporated (col. 2 lines 38-40). The alkaline substance may include ammonia, monoethanol amine and 3-methoxypropyl amine (col. 3 lines 19-26).

Therefore it would have been obvious to one of ordinary skill in the art to use the pH-indicator coloring agent as taught by Kawashima in the eradicator fluid composition of Wang because Wang teaches that either the ink or eradicating fluid may further comprise colorants that is broad enough to encompass pH-indicator colorants to provide a desired property.

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Claims 2, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US Patent 5,649,999) in view of Miller et al (US Patent 5,489,331).

Wang is described above but fails to teach stabilizer.

Miller et al teach typical stabilizing bases including sodium hydroxide, sodium carbonate and monosodium EDTA. Therefore it would have been obvious to one of ordinary skill in the art to use the stabilizers taught by Miller in the composition of Wang because Wang discloses that conventional ingredients may be present in the ink or eradicator fluid.

Claims 20-22, 24-34, 36-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US Patent 5,649,999) in view of Kawashima (US Patent 4,907,903) in further view of Miller et al (US Patent 5,489,331).

Wang teaches an ink/eradicator fluid combination includes an ink containing a dye and a binding agent, and an eradicator fluid containing a basic nitrogen compound (abstract and col. 1 lines 27-40). The ink contains a triaryl methane dye, a metal salt capable of binding to the amine used in the eradicator fluid, an organic acid, a polyacrylates film-forming polymer and water. The eradicator fluid includes a non-volatile amine capable of decolorizing the triaryl methane dye, a film-forming polymer and water (col. 2 lines 28-35). The preferred ink composition has a viscosity between 1 cps and 3 cps (col. 3 lines 12-14). The eradicator fluid contains a buffer to maintain the pH of the solution between 11 and 12 and the film-forming polymer may be a polyacrylic acid (col. 3 lines 18-60). The reference further teaches that other conventional

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ingredients such as bactericides, thickeners and colorants can be included in the ink or the eradicator fluid (col. 4 lines 11-13). The preferred inks and eradicator fluids can be used in roller ball pens, which include a tubular member for fluid communication with a reservoir; a socket, having a seat, at one end of the member, an interior wall surface extending from the seat; a rim disposed at the end of the interior wall surface opposite the seat; and a spherical ball that is disposed in the socket. The ink and eradicator fluid may be supplied in separate pens or may be supplied in a single pen, containing a reservoir for each (col. 4 lines 11-40).

Kawashima teaches a representing utensil for use in making an invisibly depicted matter visible again which houses a coloring assistant in its own container, wherein the coloring assistant is able to make a colorlessly depicted matter develop color and after its coloring, do the short-time fading at which time by acting on the depicted matter with the aid of a coloring agent (abstract and col. 1 lines 61-68). The reference teaches that the coloring agent may include an alkaline pH-indicator such as phenolphthalein, o-cresol phthalein, and bromophenol (col. 2 lines 18-33). The reference discloses that the pH-indicators may be dissolved by using alkaline solution or alcohol, wherein the solvent can be evaporated (col. 2 lines 38-40). The alkaline substance may include ammonia, monoethanol amine and 3-methoxypropyl amine (col. 3 lines 19-26).

Therefore it would have been obvious to one of ordinary skill in the art to use the pH-indicator coloring agent as taught by Kawashima in the eradicator fluid composition of Wang because Wang teaches that either the ink or eradicating fluid may further

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comprise colorants that is broad enough to encompass pH-indicator colorants to provide a desired property.

Miller et al teach typical stabilizing bases including sodium hydroxide, sodium carbonate and monosodium EDTA. Therefore it would have been obvious to one of ordinary skill in the art to use the stabilizers taught by Miller in the composition of Wang because Wang discloses that conventional ingredients may be present in the ink or eradicator fluid.

Claims 4, 11, 23, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US Patent 5,649,999) in view of Kawashima (US Patent 4,907,903) in further view of Doi et al (US Patent 6,378,999).

Wang teaches an ink/eradicator fluid combination includes an ink containing a dye and a binding agent, and an eradicator fluid containing a basic nitrogen compound (abstract and col. 1 lines 27-40). The ink contains a triaryl methane dye, a metal salt capable of binding to the amine used in the eradicator fluid, an organic acid, a polyacrylates film-forming polymer and water. The eradicator fluid includes a non-volatile amine capable of decolorizing the triaryl methane dye, a film-forming polymer and water (col. 2 lines 28-35). The preferred ink composition has a viscosity between 1 cps and 3 cps (col. 3 lines 12-14). The eradicator fluid contains a buffer to maintain the pH of the solution between 11 and 12 and the film-forming polymer may be a polyacrylic acid (col. 3 lines 18-60). The reference further teaches that other conventional ingredients such as bactericides, thickeners and colorants can be included in the ink or the eradicator fluid (col. 4 lines 11-13). The preferred inks and eradicator fluids can be

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used in roller ball pens, which include a tubular member for fluid communication with a reservoir; a socket, having a seat, at one end of the member, an interior wall surface extending from the seat; a rim disposed at the end of the interior wall surface opposite the seat; and a spherical ball that is disposed in the socket. The ink and eradicator fluid may be supplied in separate pens or may be supplied in a single pen, containing a reservoir for each (col. 4 lines 11-40).

Kawashima teaches a representing utensil for use in making an invisibly depicted matter visible again which houses a coloring assistant in its own container, wherein the coloring assistant is able to make a colorlessly depicted matter develop color and after its coloring, do the short-time fading at which time by acting on the depicted matter with the aid of a coloring agent (abstract and col. 1 lines 61-68). The reference teaches that the coloring agent may include an alkaline pH-indicator such as phenolphthalein, o-cresol phthalein, and bromophenol (col. 2 lines 18-33).

Therefore it would have been obvious to one of ordinary skill in the art to use the pH-indicator coloring agent as taught by Kawashima in the eradicator fluid composition of Wang because Wang teaches that either the ink or eradicating fluid may further comprise colorants that is broad enough to encompass pH-indicator colorants to provide a desired property.

Doi et al teach an aqueous ink composition that may comprise a polymeric dispersant including polyacrylic acid and polyethyleneimine.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced polyacrylic acid with

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polyethyleneimine because the substitution of art recognized equivalents as shown by Doi et al would have been within the level of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vfg
6-24-06


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